

REMARKS

The applicants have reviewed the Official Action mailed by the Office on 22 October 2004, and submit this paper as a fully-responsive reply thereto.

Preliminary Matters

5 Regarding the Information Disclosure Statement (IDS) submitted previously, the applicants regret the listing of certain references that were previously cited by the Office on PTO-892 forms. Regarding the non-patent documents and foreign references noted in Paragraph 1 of the Action, the applicants believe that copies of these documents and references were submitted with the IDS that was filed on 16 August 2004. However, for the convenience of the
10 Office in considering these documents and references, the applicants are re-submitting these materials in a new IDS filed with this response. The applicants thus request entry and consideration of the materials listed on this IDS, as well as those IDSs filed by the applicants after the mailing of the pending Official Action.

Independent claims 21, 68, 217, and 220, and all claims depending ultimately therefrom, stand rejected under 35 U.S.C. § 112, 2nd paragraph, as stated in Paragraphs 3 and 4 of the Official Action. To clarify these independent claims, the applicants have amended them as indicated above to remove the language “in part” and certain instances of “at least” from the indicated paragraphs. The applicants respectfully request entry of these revisions, and reconsideration and withdrawal of the § 112, 2nd paragraph, rejections of independent claims 21,
20 68, 217, and 220.

Art-Based Rejections of Independent claims 21, 68, and 217

Independent claims 21, 68, and 217, and certain claims depending ultimately therefrom, stand rejected under 35 U.S.C. § 102(b) as being anticipated by Malec. After considering the comments in the Action and the cited art, the applicants respond to the rejections of these claims
25 with the following comments and request for reconsideration.

Turning first to claim 21, the applicants submit that Malec does not support a § 102 rejection of this claim because Malec does not obtain data that truly represents a “geographic position” of the user. Claim 21 recites, among other things, selecting an item to offer based on “who” the user is (“identity of the user”) and “where” the user is (“geographic position of the

user"). The applicants submit that Malec fails to meet at least the "where" feature as recited in claim 21. Instead, the applicants submit that Malec's system of trigger transmitters and cart display electronics serves to obtain data representing "what" goods the shopper is near within the store, rather than "where" the shopper actually is within the store. Having captured data 5 indicating "what" goods the shopper is near, Malec can then present data on the card display electronics accordingly. However, the applicants submit that if, for example, the bread section in Malec were moved elsewhere within the store, and the data bases supporting the Malec transmitters and display electronics were updated accordingly, then the items displayed to shoppers when they approach the "new" bread section would remain the same as those presented 10 when they previously approached the "old" bread section, regardless of the move. The applicants submit that this observation reinforces their contention that Malec's messages are chosen based not on "where" the shopper is, but instead on "what" goods the shopper is near. Because Malec's system serves a proxy or indicator for "what" goods the shopper might be near, the applicants submit that Malec does not support a rejection of their claims reciting a user's 15 "geographic position" as an input to determine the item to offer. On at least this basis, the applicants request reconsideration and withdrawal of the § 102(b) rejection of claim 21, and all claims depending therefrom, as being anticipated by Malec.

Independent claims 68 and 217 also recite obtaining data representing the geographic position of the user, and the applicants submit that the above comments are equally applicable to 20 these other claims. On at least this basis, the applicants request reconsideration and withdrawal of the § 102(b) rejection of claims 68 and 217, and all claims depending therefrom, as being anticipated by Malec.

Amendments to Claims 208, 210, and 217

The applicants have amended claims 208, 210, and 217 to recite further features not 25 believed disclosed or fairly suggested by Malec. For the sake of conciseness, the applicants discuss only dependent claim 208 in detail, but these same comments apply equally to the other amended claims 210 and 217 as well.

Turning to claim 208, which depends from independent claim 21, the applicants 30 reproduce the following language from that claim, as it would stand after entry of the above amendments, for convenience of discussion:

“... wherein obtaining primary transaction data includes obtaining both of the data representing the identity of the user and the data representing the geographic position of the user in connection with a *single given primary transaction involving the user*,”

5 The applicants submit that the language recited in this claim is fully supported under 35 U.S.C. § 112, 1st paragraph, by United States Patent No. 6,055,513 (hereafter the “‘513” patent), which is a parent application of the instant application. In the telephonic embodiments disclosed by the ‘513 patent, users or callers 74 initiate contact with the telemarketing system 40 (and ultimately with those merchant-offerors providing upsell items through the system 40) to conduct 10 primary transactions, as discussed at least at column 15, lines 43-46 of the ‘513 patent. Thus, in the telephonic embodiments, the users or callers 74 would initiate contact by dialing or otherwise activating a telephone or other similar telephonic or electronic communications device. As discussed in the ‘513 patent at least at column 9, line 30, a given primary transaction involving respective users or callers 74 can provide data, for example through the ANI service, that is 15 helpful in identifying and locating a given caller 74. While the system 40 may need to convert or map the data provided by ANI to identify and locate the given caller 74 (e.g., refer to one or more databases using the ANI data as a key), the given caller 74 need only conduct a single given primary transaction to initiate the process that results ultimately in identifying and locating the user. On at least this basis, the applicants submit that the ‘513 patent fully supports the 20 subject matter recited in amended claim 208.

 In addition to the comments directed above to independent claim 21, the applicants submit that Malec fails to disclose or fairly suggest at least the above features recited in amended claim 208. As suggested at the bottom of page 4 of the Official Action, Malec initiates a primary transaction in two ways. First, to provide the identification information, the Malec shopper 25 swipes a smart card through a suitable reader. Second, to provide the “location” information, the Malec shopper navigates his or her cart near one of the trigger transmitters located throughout the store. As discussed above, the applicants submit that this latter action results not in information indicating geographic position, but instead information indicating which goods the shopper is near. Nevertheless, to the extent that these two actions taught by Malec are read as 30 two separate primary transactions, the applicants respectfully submit that Malec would not support a rejection of amended claim 208, which recites that both the identification information

and the geographic position information are obtained in connection with a single primary transaction involving the user. If Malec is read to require two separate primary transactions to provide this same identification and geographic position information, the applicants submit that Malec fails to support a rejection of amended claim 208.

5 Similar subject matter is recited in amended dependent claim 210, which depends from independent claim 68, and in independent claim 217. The applicants submit that the same comments relating to § 112, 1st paragraph, support apply equally to these other amended claims. Also, the above comments directed to amended claim 208 relative to the cited art are believed 10 equally applicable to these other amended claims 210 and 217 as well. Thus, on at least this basis, the applicants respectfully request entry of the above amendments, and reconsideration and withdrawal of the rejections of at least these amended claims 208, 210, and 217.

Amendments to Pending Dependent Claims 209, 211, and 218

15 Pending dependent claims 209, 211, and 218 stand rejected under § 102(b) as anticipated by Malec. These claims depend from independent claims 21, 68, and 217, respectively. The applicants have amended these dependent claims 209, 211, and 218 as indicated above, and submit that these revisions are fully supported under 35 U.S.C. § 112, 1st paragraph, on at least 20 the same basis as are the revisions to claims 208, 210, and 217, as discussed above.

In addition to the comments directed above to independent claims 21, 68, and 217, the applicants respectfully submit that Malec fails to support § 102 rejections of at least dependent 25 claims 209, 211, and 218. These dependent claims recite various aspects of obtaining the data representing the identity and the geographic location of the user in connection with a single action taken by the user to initiate contact with a system associated with the offeror. As suggested at the bottom of page 4 of the Action and discussed by the applicants above, Malec appears to require its users to perform two separate actions to enable the Malec system to (1) identify and (2) “locate” the shoppers (i.e., first, swipe a card, and second, navigate shopping cart near a transmitter). To the extent that these two separate actions required by Malec are read as a single primary transaction comprising two separate actions, the applicants submit that Malec fails to support a § 102 rejection of dependent claims 209, 211, and 218. These dependent 30 claims recite, in part, obtaining the identification and location data in connection with a single action taken by the user to initiate contact with a system associated with the offeror. On at least

this basis, the applicants request reconsideration and withdrawal of the § 102 rejections of at least these dependent claims 209, 211, and 218.

Solely to expedite prosecution of the instant application, claims 220-223 are cancelled herein without any prejudice, waiver, or disclaimer of the applicants' rights to direct other claims
5 to the subject matter recited in these or other claims.

The applicants request favorable action at the earliest convenience of the Office.

Respectfully submitted,

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